

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 23, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Animation Science Corporation

Serial No. 75/264,985
Serial No. 75/264,986
Serial No. 75/264,987
Serial No. 75/264,988

Lori N. Boatright and Charles T. J. Weigell of Blakely,
Sokoloff, Taylor & Zafman for Animation Science
Corporation.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Michael A. Szoke, Managing Attorney).

Before Hairston, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Four separate applications were filed by Animation
Science Corporation to register two different marks. Two
applications are for the mark ANIMATION SCIENCE, one for
"computer software for animation and for the graphic
simulation of processes and phenomena for use in various
applications" in International Class 9 (application Serial

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

No. 75/264,985), and one for "computer software development and project management; training and software support and other consultation services in connection with computer software" in International Class 42 (application Serial No. 75/264,986).¹ Two applications are for the mark shown below (one for the above-identified goods, application Serial No. 75/264,988, and one for the above-identified services, application Serial No. 75/264,987).

All four applications were filed on March 27, 1997, based on claimed dates of first use and first use in commerce of February 19, 1997 and February 27, 1997, respectively.

In view of the common questions of law and fact which are involved in these four applications, and in the interests of judicial economy, we have consolidated the applications for purposes of final decision. Thus, we have issued this single opinion.

Registration of the two word mark applications

¹ In the two service mark applications (application Serial Nos. 75/264,986 and 75/264,987) the acceptability of the registration

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

of services is an issue in this appeal and will be fully addressed later in this opinion.

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

(application Serial Nos. 75/264,985 and 75/264,986) has been finally refused under Section 2(e)(1) of the **Trademark Act, 15 U.S.C. §1052(e)(1)**, on the basis that, when used on applicant's goods and services, the mark **ANIMATION SCIENCE** is merely descriptive of them.

Registration of the two design mark applications (application Serial Nos. 75/264,987 and 75/264,988) has been finally refused based on applicant's failure to comply with a requirement that applicant disclaim the descriptive words "ANIMATION SCIENCE" apart from the mark as shown, under Section 2(e)(1) of the **Trademark Act, 15 U.S.C. §1052(e)(1)**, and Section 6 of the **Trademark Act, 15 U.S.C. §1056**.

There is a second basis for refusal in the two service mark applications (application Serial Nos. 75/264,986 and 75/264,987), specifically, registration has been finally refused based on applicant's failure to comply with a requirement for a more definite recitation of services.

Applicant has appealed, and briefs have been filed in each application. An oral hearing was not requested.

We turn first to the question of whether the words "ANIMATION SCIENCE" are merely descriptive as applied to the involved goods and/or services.

The Examining Attorney contends that ANIMATION SCIENCE is merely descriptive with respect to both applicant's goods and services because "animation science" is a "systematized knowledge or a branch of knowledge pertaining to animation"; or in a narrower sense it is a "systematized field of knowledge in which scientific principals (sic) are used in the animation process." Specifically, with regard to applicant's goods, she contends that applicant's computer software is "used to create animated effects" and "has applications in the field of animation science" and "is based upon and employs principals (sic) of animation science to create better animated effects"; and with regard to applicant's services, that they "pertain to the creation of animated effects" and are "based upon and employ principals (sic) of animation science to create better animated effects." The Examining Attorney concludes that ANIMATION SCIENCE is merely descriptive of a significant aspect or attribute of applicant's goods and services.

The record (in each application) in support of the refusal to register under Section 2(e)(1) consists of dictionary definitions of the words "animate," "animation," and "science"²; four excerpted stories from Nexis which

² The Examining Attorney submitted with her brief a second dictionary definition of the word "science," and she requested

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

include the words "science of animation"; and applicant's specimens of use for its goods or services.

Applicant urges reversal of the refusal on the basis that the mark ANIMATION SCIENCE, when viewed in its entirety, is suggestive, not merely descriptive, of applicant's goods and services; that common words, when used together, may become a valid trademark; that the Examining Attorney's dictionary evidence does not demonstrate that the mark, taken as a whole, is merely descriptive; that "animation" is not a field of scientific study, but is a creative field largely devoted to entertainment and the communication of graphic images; that the mark ANIMATION SCIENCE is "an abstract concept creating an impression of academic sophistication" for the involved goods and services; that the mark is "an incongruous and conspicuously evocative word combination"; that there is no evidence of use by others of the combination of words "ANIMATION SCIENCE"; and that doubt is resolved in applicant's favor.

It is well settled that "a term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]."

that the Board take judicial notice thereof. The request is granted. See TBMP §712.01.

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

(Emphasis added). In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, the immediate idea must be conveyed with a "degree of particularity." In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1978); and In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd, unpub'd, Fed. Cir. February 13, 1991. As the Court stated in In re Abcor Development, supra: "Although a mark may be generally descriptive, if it also functions as an indication of origin, it is not 'merely descriptive.'"

Of course, whether a term or phrase is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term or phrase would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). See also, In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

Viewing the record in its entirety, we find that the Examining Attorney has not established a prima facie showing that the mark ANIMATION SCIENCE, taken as a whole,

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

is merely descriptive of either applicant's computer software or its computer software related services. The fact that applicant's specimens of use include words which apparently relate to the technology involved in creating animated images (e.g., "particle dynamics," "visual simulation technology," "rules of physics") does not establish that "science" or "animation science" immediately conveys to the relevant purchasers an idea of the significant characteristics of applicant's involved goods and services. The term "science," as evidenced by the dictionary definitions, is a very broad term which does not convey an immediate idea of the attributes or features of applicant's goods and services. Likewise, the four Nexis excerpts submitted by the Examining Attorney are unpersuasive. Specifically, three of the stories appear to relate to a children's workshop in New York on the "science of animation"; and the fourth excerpt consists of a single sentence about looking at the "art and science of animation," the context of which is not apparent on its face. ANIMATION SCIENCE is ambiguous, requiring a modicum of thought in order to determine therefrom that applicant's goods and services involve computer software and computer software related services relating to animation. See *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

(Fed. Cir. 1988) (wherein the Court majority's discussion of the term "technology" was within the context of whether the mark HUTCHINSON TECHNOLOGY was primarily merely a surname, but the Court stated "the fact that the term 'technology' is used in connection with computer products does not mean that the term is descriptive of them. Many other goods possibly may be included within the broad term 'technology'"); and *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054 (TTAB 1989) (wherein the Board found the mark CONCURRENT TECHNOLOGIES CORPORATION was not merely descriptive for printed electronic circuit boards).

Moreover, we note that the Examining Attorney did not submit any evidence whatsoever demonstrating that the mark ANIMATION SCIENCE, as a whole, is used in a descriptive sense.

The burden of proving that applicant's mark is merely descriptive rests with the Examining Attorney. The record before us does not show that the term ANIMATION SCIENCE has a readily recognized meaning with regard to the involved goods and services.

Finally, if doubt exists as to whether a term is merely descriptive, it is the practice of this Board to resolve doubts in favor of the applicant and pass the

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

application to publication. See *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, descriptive, may oppose and present evidence on this issue to the Board.

Accordingly, the refusal to register under Section 2(e)(1) and/or Section 6 is reversed in each application.

Turning then to the issue of the identification of services in application Serials Nos. 74/264,986 and 75/264,987, the first Examining Attorney did not accept the original identification of services, but suggested two different recitations of services for two separate service classes. In response thereto, applicant deleted reference to "training" and offered the following amendment to its identification of services: "design and development of computer software for others; providing computer software support; computer software consultation including project management" in International Class 42. The second Examining Attorney rejected as indefinite the last two parts of the proposed identification of services, and suggested a different identification therefor.

Both applicant and the Examining Attorney argued the issue of a proper identification of services based on the proposed amended identification of services. Thus, our

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

decision relates to the question of the acceptability of the proposed amended identification.

Section 1(a)(1)(A) of the **Trademark Act**, 15 U.S.C. §1051(a)(1)(A), requires that the written application specify the goods or services on or in connection with which applicant uses the mark. Trademark Rule 2.33(a)(1)(v) requires, in relevant part, that a trademark application must set forth "the particular goods or services" with which the mark is used. Further, the identification of goods or services must be specific and definite. See TMEP §§804.01, and 1301.05. It is within the discretion of the Patent and Trademark Office to require that the goods or services be specified with particularity. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298 (TTAB 1986), and cases cited therein, *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1998).

We have carefully reviewed the identification of services in these two applications and we find the Examining Attorney's requirement for a more definite identification of services to be well taken because the language proposed by applicant does not clearly and with the necessary specificity identify applicant's services. The Examining Attorney explained that applicant's proposed

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

identification of services -- "providing computer software support" -- is indefinite and too broad because it could encompass "training classes, programming services, computer software updating services, or technical assistance." The identification -- "computer software consultation including project management" -- is also indefinite, first, because "including" is itself an indefinite term as explained in TMEP §804.08(c). Further, "project management" is not a subset of consultation, but rather is an independent service and could relate to business project management, or computer system project management, etc. The latter two portions of the current identification of services submitted by applicant could encompass services in different classes.

Under Patent and Trademark Office identification and classification requirements, the two above-mentioned parts of applicant's identification of services are unacceptable, and the Examining Attorney's requirement for a more definite identification of services is proper. See *In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985).

In the unusual circumstances herein, the Board will allow applicant time to submit an amendment to the identification of services in each of the two service mark applications.

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

Decision: The refusal to register under Section 2(e)(1) in the two word mark cases (application Serial Nos. 75/264,985 and 75/264,986) is reversed; and the refusal to register under Sections 2(e)(1) and 6 in the two word and design mark cases (application Serial Nos. 75/264,987 and 75/264,988) is also reversed.

The refusal to register based on the requirement for a more definite recitation of services in application Serial Nos. 75/264,986 and 75/264,987 is affirmed.

However, applicant is allowed until thirty days from the mailing date stamped on this order to submit a proposed amendment to the identification of services in both application Serial No. 75/264,986 and application Serial No.75/264,987 which reads as follows:

“design and development of computer software for others; computer software consultation services in the field of computer software information and project management.”

If the above amendment is submitted within thirty days from the mailing date in each of the two service mark applications, this decision will be set aside as to the refusal to register in those two applications based on the requirement for a more definite identification of services,

Ser. Nos. 75/264985, 75/264986, 75/264987 & 75/264988

and the service mark applications will then be forwarded to publication for opposition.

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B. A. Chapman

C. M. Bottorff
Administrative Trademark Judges,
Trademark Trial and Appeal Board